

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: ANDREW I HICKSON, SIMON A.J. HOLDSWORTH,
TIMOTHY N. HOLLOWAY, PETER R. MACFARLANE,
MICHAEL J. WARD

Appeal No 2008-1381
Application 10/016,906

Mailed: September 3, 2008

Before KRISTA ZELE *Deputy Chief Appeals Administrator*
ZELE, *Deputy Chief Appeals Administrator*.

ORDER REMANDING TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on January 18, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being remanded to the Examiner to address the following matter(s) requiring attention prior to docketing.

Please note the Examiner didn't have the necessary appeals conference (only listed himself as a conferee). Also as the Appeal Center Return dated August 13, 2007, besides missing the conferee signatures, he was advised that the Evidence Relied Upon section didn't list the Owens patent that he used in the rejection(s) of record. No correction have been made to date.

EXAMINER'S ANSWER, EVIDENCE RELIED UPON

Section 1207.02 of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007) states:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The Examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

- (8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and in the case of nonpatent references, the relevant page or pages.

The Examiner's Answer mailed June 12, 2007 is deficient because the "Evidence Relied Upon" section fails to include the reference(s) Owens et al., Patent No. 6,633,630 cited on page(s) 3 in the Examiner's Answer's grounds of rejection of 2-16,18-21 and 23 rejected under 35 USC § 102. Correction is required.

EXAMINER'S ANSWER, MISSING SIGNATURES

An appeal conference is mandatory in all cases in which an acceptable appeal brief has been filed and a determination to move forward on appeal has been made. The participants of the appeal conference should include (1) the Examiner charged with preparation of the Examiner's answer, (2) a supervisory patent Examiner (SPE), and (3) another Examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. On the Examiner's answer, below the primary Examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. The Answer must also include the signature of a TC Director or designee to indicate that he or she approves any new grounds of rejection, if presented.

A review of the file finds that the Examiner's answer is missing either at least one typed/ printed name of the appeal conference participants and/or is missing at least one initial or signature to make the record clear the appeal conference was held in accordance with MPEP § 1207.01. Therefore, correction is required.

CONCLUSION

Accordingly, it is **ORDERED** that the application is
REMANDED to the Examiner:

- 1) to vacate the Examiner's Answer mailed June 12, 2007;
- 2) to include the approval of the necessary conferees; and
- 3) to generate a revised Examiner's Answer correctly setting forth the
Evidence Relied Upon section and to correct other sections of the Answer as
may be required.

If there are any questions pertaining to this Remand, please contact
the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/LP

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